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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Alan L. FERGUSON et al.) Group Art Unit: 2191
Application No.: 10/016,785) Examiner: M. Steelman
Filed: December 6, 2001) Confirmation No. 3421
For: SYSTEM AND METHOD FOR)
REMOTELY MODIFYING)
SOFTWARE ON A MACHINE)

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

Pursuant to 37 CFR § 41.41(a)(1), Appellant presents this Reply Brief in response to the Examiner's Answer mailed on December 8, 2006, the period for response to which extends through February 8, 2006.

REMARKS

In addition to the arguments for reversal of the outstanding final rejection provided in Appellants' Appeal Brief filed on December 14, 2005, Appellants provide the following remarks in response to the Examiner's Answer ("Answer") mailed on December 8, 2006.

With respect to the rejection of independent claim 1, the Examiner asserts that that *Cantos* discloses “a remote data storage system for storing identifying information of said software,” “a remote processor for monitoring said remote data storage system to determine if updates are available for said software,” and “a remote communications system receiving said available updates from said remote processor and relaying said available updates to said...machine for storage.” Answer at 3-4. Further, the Examiner asserts that *Lee* discloses “non-volatile memory.” Answer at 4. The Examiner admits that neither *Cantos* nor *Lee* disclose “that the invention was installed on a ‘work machine.’” Answer at 5. However, claim 1 recites, among other things, “a system for updating software installed on a work machine, the work machine having at least one non-volatile memory for storing the software,” and “a remote communications system ... relaying said available updates to said work machine for storage in said non-volatile memory.” In order to remedy the deficiencies of *Cantos* and *Lee*, the Examiner introduces *Hanson*. Answer at 5. In particular, the Examiner asserts that “*Hanson* disclosed updating software installed on a work machine.” *Id.* Appellants respectfully submit that *Hanson* does not remedy the deficiencies of *Cantos* and *Lee*.

Hanson does not teach “a system for updating software installed on a work machine, the work machine having at least one non-volatile memory for storing the software,” or “a remote communications system ... relaying said available updates to said work machine for storage in said non-volatile memory,” as required by claim 1. Instead, *Hanson* describes a portable data terminal (Fig. 1, element 10, and Fig. 16, element 300) that may be removably connected to a vehicle data bus via a docking station (Fig. 16, element 330). In one embodiment, portable data terminal 300 may be

used with two docking stations, one in the vehicle and one at a remote location. *Hanson*, col. 17, ll. 38-43. Thus, *Hanson* teaches away from the use of a remote communications system by utilizing a portable data terminal that is movable between a vehicle and a remote storage location. *Hanson* teaches that item information contained in bar codes and radio-frequency identification tags is scanned and stored in memory 370. *Hanson*, col. 6, ll. 7-8. In certain embodiments, data terminal 10, 300, is used by a vehicle operator to track items by scanning bar codes attached to the items. *Hanson*, col. 2, ll. 20-25. However, storage means 370, is contained within data terminal 300, rather than on a work machine, as required by claim 1. *Hanson*, Fig. 16; col. 17, ll. 45-47. Therefore, *Hanson* does not teach this limitation.

Further, *Hanson* does not teach “updating software installed on a work machine,” and “relaying said available updates to said work machine for storage in said non-volatile memory,” as required by claim 1. In support of the rejection, the Examiner alleges that *Hanson*’s teaching that “the terminal contained data storage means mounted at 370 (e.g. including one-half megabyte of RAM, and EPROM) and microcomputer operated control means mounted at 380, with the EPROM containing downloading/uploading control programming [updating software installed on a work machine] and application programming in RAM storage of means 370 for controlling on board-devices and for receiving and storing data from a multiplicity of on-board analog and digital sensors as a basis for such control,” amounts to “updating software on a work machine.” Answer at 5-6 (emphasis added). Appellants respectfully disagree with this assertion. The Examiner mischaracterizes *Hanson*. The language quoted by the Examiner refers to programming that facilitates communication of information between,

and control of, the various components of the data capture system. In other words, this refers to the communicative interaction between devices making up the data capture system. *Hanson*, col. 17, ll. 50-54. As *Hanson* states, “it was possible to use terminal 300 in an on-board receptacle to collect data from vehicle sensors such as indicated at 61-65, FIG. 4, and then to remove the terminal from the vehicle receptacle and transport the terminal to a home or home office receptacle where data from the terminal could be loaded into a personal computer or the like.” *Hanson*, col. 17, ll. 37-44. Thus, storage means 370 collects information from the vehicle, but it does not update the vehicle. *Hanson* explicitly states that storage means 370 is intended to store and receive data, rather than upload new data to update the vehicle programming as proposed by the Examiner. Nowhere does *Hanson* teach that this programming is updated, or that software updates of any sort are relayed to the vehicle. In fact, *Hanson* does not even suggest that this would be possible. Therefore, *Hanson* does not teach “updating software installed on a work machine,” and “a remote communications system ... relaying said available updates to said work machine for storage in said non-volatile memory,” as claimed.

Further, even assuming *Cantos*, *Lee*, and *Hanson* did teach each and every limitation recited in independent claim 1, which Appellants deny, one of ordinary skill in the art would not have been motivated to combine the references as proposed to arrive at the claimed invention. The Examiner asserts that it would have been obvious to combine *Hanson* to *Cantos* and *Lee* because: (i) “vehicle controllers / computers are known in the art and maintaining, updating the controllers enhances the value of such equipment;” (ii) “[t]he ability to (*Hanson*, col. 1, line 53) ‘survive rough handing’ was

suggested by Hanson to demonstrate a computer / controller in a ‘work environment;’” and (iii) “Hanson disclosed the need to download / upload control programming and application programming (col. 2, lines 6-12), a data capture system, which could be quickly and simply loaded in a relatively foolproof manner, without requiring attention and care from operators engaged in physically demanding and arduous work routines.”

Answer at 12-13. Appellants respectfully disagree with the Examiner’s position for the following reasons.

Determinations of obviousness must be supported by evidence on the record. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching factual inquiry.” *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52.). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, the M.P.E.P. § 2143.01 makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted).

The first motivation provided by the Examiner, specifically, that “vehicle controllers / computers are known in the art and maintaining, updating the controllers enhances the value of such equipment,” is a conclusory statement, and it is not gleaned from the cited

references or otherwise supported by evidence on record. In other words, this motivation was reconstructed in hindsight in order to improperly reject claim 1 under § 103. As such, the motivation is not supported by “substantial evidence” resulting from “thorough searching and factual inquiry.”

The second motivation provided by the Examiner, specifically, that “[t]he ability to (Hanson, col. 1, line 53) ‘survive rough handing’ was suggested by Hanson to demonstrate a computer / controller in a ‘work environment,’” is wholly unrelated to “updating software installed on a work machine,” and “relaying said available updates to said work machine for storage in said non-volatile memory,” which the Examiner incorrectly alleges that *Hanson* teaches. *Hanson* refers to the desirability of the handheld terminals to be made of a rugged construction to survive rough handling. *Hanson*, col. 1, ll. 51-53. This desire for rugged construction is completely unrelated to “updating software on a work machine,” and “relaying said available updates to said work machine for storage in said non-volatile memory,” as claimed. Therefore, *Hanson* does not “suggest the desirability of the combination.”

The third motivation provided by the Examiner, specifically, that “Hanson disclosed the need to download / upload control programming and application programming (col. 2, lines 6-12), a data capture system, which could be quickly and simply loaded in a relatively foolproof manner, without requiring attention and care form operators engaged in physically demanding and arduous work routines,” is also completely unrelated to “updating software installed on a work machine,” and “relaying said available updates to said work machine for storage in said non-volatile memory.” *Hanson* refers to the desire for the handheld terminal to be easily inserted and removed from a docking

apparatus (see Figs. 1 and 2, items 11 and 31-36), by avoiding the use of mating pins, electrical socket connectors, and the like, which make insertion and removal thereof difficult, so that terminal users may focus their attention on aspects of their work routines. *Hanson*, col. 2, ll. 6-15. Thus, the desire for ease of insertion and removal of a held terminal(s) from a docking apparatus is wholly unrelated to “updating software on a work machine,” and “relaying said available updates to said work machine for storage in said non-volatile memory,” as claimed. Therefore, as discussed above in connection with the second motivation, *Hanson* does not “suggest the desirability of the combination.”

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The Court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.* In this case, the Examiner merely alleged that *Hanson* discloses certain elements without showing reasons why a skilled artisan would select or modify those elements in the manner claimed and without showing that the claimed invention as a whole would have been obvious. Discussing the particulars of *Hanson* to assert a motivation to

combine the reference with *Cantos* and *Lee* does not suffice to establish a *prima facie* conclusion of obviousness. See, e.g., Answer at 12-13 and 18.

Therefore, as discussed above, *Cantos*, *Lee*, and *Hanson* do not teach each and every element of independent claim 1. Further, notwithstanding this deficiency, the Examiner has not provided evidence as to why one of ordinary skill in the art would have been motivated to combine *Cantos*, *Lee*, and, *Hanson*, as proposed. Therefore, the Examiner has not established a *prima facie* case of obviousness with respect to independent claim 1, and Appellants respectfully request that the § 103 rejection of this claim be reversed. Further, since claims 2-11 depend directly or indirectly from independent claim 1, Appellants also respectfully request reversal of the § 103 rejection of these claims as well.

Independent claim 12, although slightly different in scope, recites limitations similar to those of independent claim 1. Specifically, claim 12 recites, among other things, “updating software on a work machine,” and “relaying said available update from said remote data storage system to said work machine; and installing said available update in non-volatile memory.” Therefore, for at least the same reasons discussed above in connection with claim 1, Appellants respectfully request that the § 103 rejection of claim 12 be reversed. Further, since claims 13-25 depend from claim 12, Appellants also respectfully request the reversal of the § 103 rejection of these claims as well.

Independent claim 26, although slightly different in scope, recites limitations similar to those of independent claim 1. Specifically, claim 26 recites, among other things, “a system for updating software installed on a work machine, the work machine having at least one non-volatile memory for storing the software,” and “means for remotely

communicating with the work machine to relay said available updates to the work machine for storage in said non-volatile memory." Therefore, for at least the same reasons discussed above in connection with claim 1, Appellants respectfully request that the § 103 rejection of claim 26 be reversed. Further, since claim 27 depends from claim 26, Appellants also respectfully request the reversal of the § 103 rejection of this claim as well.

Conclusion

For the reasons given above, in addition to the reasons provided in Appellants' Appeal Brief of December 14, 2005, Appellants respectfully submit that the § 103 rejection of claims 1-27 are in error and should be reversed.

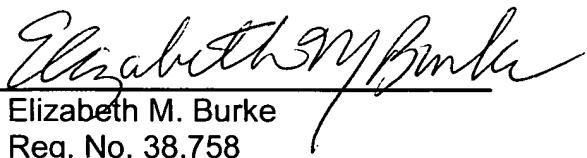
If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 8, 2007

By:


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